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Paper Number 10

In re application of
Louis F. Aprigliano et al.
Serial No. 09/656,017
Filed: September 7, 2000
For: METHOD OF PRODUCING CORROSION RESISTANT METAL ALLOYS WITH IMPROVED STRENGTH AND DUCTILITY

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed November 8, 2001.

On October 11, 2001, a first office action was mailed by the examiner, rejecting all of the elected claims present in the application (paper no. 4). Applicants responded to this office action with a response filed on October 17, 2001 (paper no. 5). A final rejection was then mailed November 8, 2001 (paper no. 6). A response was filed by applicants to the final rejection on November 15, 2001 (paper no. 7) and an advisory action was mailed by the office on December 5, 2001 (paper no. 8). Applicants also requested in the response after final that the finality of the November 8, 2001 be withdrawn because it was improper.

On December 13, 2001, the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of finality of the November 8, 2001 office action.

Applicants position for the withdrawal of the finality is that the examiner did not fully address all of the limitations present in the claims. Accordingly, it is urged by petitioner that the final office action is incomplete.

DECISION

Section 706.07 of the MPEP states:

> Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

In the first office action mailed (paper no. 4) the examiner rejected all claims under 35 USC 102 and/or 35 USC 103. In the response filed by applicants, amendments were made to all of the claims. For the most part, these amendments merely added previously claimed subject matter into the independent claims and rewrote limitations that were already present in the claims. However, a specific range limiting the components of the alloy was added to claim 2. Additionally, applicants argued several features of the claims including the limitation requiring the formation of an alloy containing high strength and ductility. In the examiner's final rejection, applicant's arguments were not specifically addressed. The examiner merely brushed aside applicant's arguments using case law stating that Applicant cannot argue combined references individually and that no impermissible hindsight was used to formulate the rejection. No mention was made of the high strength and ductility limitation and no mention was made of the limitations added to claim 2 requiring a specific alloy to be formed. The office action was therefore incomplete.

Because the record does not clearly point out and state the examiner's position on several issues raised by applicant, the finality of the office action is premature. This application is being forwarded to the examiner in order to prepare a new office action clearly stating the positions of the examiner regarding the amendment filed by applicant and the arguments set forth therein. Accordingly, the petition for withdrawal of finality is **GRANTED**

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